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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/074,834

02/13/2002

Edward Raynes Eaton

TH1871Y

6354

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7590

02/20/2007

SHELL OIL COMPANY

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EXAMINER

OGDEN JR, NECHOLUS

ART UNIT

PAPER NUMBER

1751

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/074,834

Applicant(s)

EATON ET AL.

Examiner

Necholus Ogden

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-11-2006 has been entered.

Election/Restrictions

2. This application contains claims 7-11 drawn to an invention nonelected with traverse in Paper No. September 27, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1 and 4-6 remain pending in the present application.

Claims 1 and 4-6 rejected under 35 U.S.C. 102(b) as anticipated by or in the alternative, obvious under 35 U.S.C. 103(a) over Nambu (4,925,603) is withdrawn in view of applicant's arguments.

Rejections

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fitzpatrick et al (4,617,490).

Fitzpatrick et al disclose a cathode ray tube device with improved color filtering system comprising 20 to 80% by weight of an alcohol such as 1,3 propanediol that not

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only act as a filtering medium but is an excellent coolant for the tube during operation while rendering the tube resistant to freezing during storage (col. 2, lines 20-37).

As this reference appears to teach all of the instantly required it is considered anticipatory.

In the alternative, Fitzpatrick et al is silent with respect to the electrical resistivity, boiling point, thermal conductivity, viscosity, heat capacity, and rejecting surface capacity. However, it would nonetheless been inherent to the compositions of Fitzpatrick to encompass the above mentioned characteristics because the compositions of Fitzpatrick et al specifically teach with sufficient specificity the specific 1,3 propanediol (trimethylene glycol) for the use as solution that has coolant and antifreeze properties. Therefore, the skilled artisan would have expected similar characteristics of the solutions disclosed in Fitzpatrick et al, in the absence of showing to the contrary.

1. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP (06026979).

JP '979 discloses a leak detecting liquid composition comprising an antifreeze agent, water, rust preventing agent and preservatives. JP '979 specifically teaches that said composition comprises as an antifreeze agent 1,3-propanediol, quaternary ammonium salt as a preservative, and a nitrite salt as a preventing agent (see abstract and title).

As this reference teaches all of the instantly required it is considered anticipatory.

In the alternative, JP '979 is silent with respect to the electrical resistivity, boiling point, thermal conductivity, viscosity, heat capacity, and rejecting surface capacity. However, it would nonetheless been inherent to the compositions of JP '979 to encompass the above characteristics because the compositions of JP '979 specifically teach with sufficient specificity the specific 1,3 propanediol (trimethylene glycol) for the use as solution that has coolant and antifreeze properties.

Response to Arguments

2. Applicant's arguments filed 12-11-2006 have been fully considered but they are not persuasive.

3. Applicant argues that the compositions of Fitzpatrick do not necessarily have the electrical resistivity since Fitzpatrick teaches other solvents or alcohols may be used. The examiner contends that anticipation may include additional components that are named. For it is held that "When the species is clearly named, the species claim is anticipated no matter how many other species are additionally named". Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) See also In re Sivaramakrishnan, 673 F.2d 1383, 213USPQ 441 (CCPA 1982).

Applicant argues that the additional components such as the coloring filtering system, increases the conductivity.

The examiner contends that applicant's specification permits and requires additional components, such as salts and acids which act as inhibitors, (pages 6-9 of applicant's specification) and Fitzpatrick does include additional ingredients such as salts as stated by applicant. Therefore, the examiner takes the position that these

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additional salt ingredients admixed with the PDO would inherently encompass the electrical resistivity requirement.

Applicant argues that the Declaration submitted 12/11/06 shows that electrical resistivity of at least 250 Kohm-cm.

The examiner contends that the Declaration of Mr. Glenn Komplin (Exhibit A) does not compare the closest prior art of record with the claimed invention, but submits a Declaration that speaks of the conductance of PDO and deionized water and PDO and tap water. This bears little weight upon the patentability of the claimed invention. First, the claimed invention is not based upon deionized water rather the claims state an aqueous composition which reads on any type of water being employed in said composition. Secondly, Applicant has not shown or measured the conductance of Fitzpatrick as it relates to the limitations of the claimed invention. Finally, the examiner does not dispute the fact that conductivity varies amongst different proportions of PDO and water (deionized or tap) but that this bears little relevance with the claimed invention. *An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." In re Merchant, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978)*

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Double Patenting

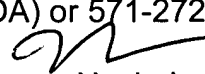
Claims 1 and 4-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/886,298.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-T, Th-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Necholus Ogden
Primary Examiner
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2-15-2007